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Supreme Court, U.S.

FILED

OCT 24 1989

JOSEPH F. SPANIOL, JR.
CLERK

NO. 89-584

IN THE SUPREME COURT
OF THE UNITED STATES

OCTOBER TERM, 1989

IN RE: JOHN R. MARIK,
Petitioner.

EX-PARTE

MOTION FOR JUDICIAL NOTICE OF COURT OPINION

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202

QUESTION PRESENTED

Should specified Court Opinion be
judicially noticed?

TABLE OF CONTENTS

QUESTION PRESENTED.....	1
BASIC MOTION.....	1
1. Nature of Court Opinion.....	2
2. Appealability of Contempt Order.....	2
3. Judicial Notice of Historical Facts...	4
Prayer for Relief.....	7
Appendix.....	App. 1

TABLE OF AUTHORITIES

1. Cases

Christian Science Bd. of Directors v.
Evans, et al,
105 N.J. 297 (1987).....7

General Conference Corporation of Seventh-
day Adventists v. Seventh-day Adventist
Congregational Church and John R. Marik,
U.S. Ninth Circuit Court of Appeals.
No. 88-2506.....1,7

Grant v. Phoenix Mutual L. Ins. Co.,
106 U.S. 429 (1882).....4

Thomassen v. U.S.,
835 F.2d 727 (C.A. 9, 1987).....3

Union of Prof. Airmen v. Alaska
Aeronautical,
625 F.2d 881 (C.A. 9, 1980).....3

2. Federal Rules

Federal Rule of Evidence 201.....1,4,7

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IN RE: JOHN R. MARIK,
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MOTION FOR JUDICIAL NOTICE OF COURT OPINION

Petitioner, John R. Marik, by and through his attorney, Max A. Corbett, moves the Court, pursuant to the provisions of Rule 201(d) of the Federal Rules of Evidence to take judicial notice of the Opinion of the United States Ninth Circuit Court of Appeals rendered on October 5, 1989, in the case of General Conference Corporation of Seventh-day Adventists v. Seventh-day Adventist Congregational Church and John R. Marik, Case No. 88-2506, copy attached and included in the Appendix hereto, as being supportive of the following specified matters:

1. In the Petition for Writ of Habeas Corpus submitted in this Case, one of the two questions presented for the Court's determination is: "Has John R. Marik been unduly restrained of his liberty?" The Court Opinion dated October 5, 1989, above referenced, clearly evidences that Judgment of the trial court from which appeal was made was improper, and therefore the Order of the trial court ordering the issuance of a warrant for the arrest of John R. Marik was invalid. Accordingly, the United States Court of Appeals has, effectively speaking, answered the question posed in the affirmative. Nevertheless, due to the fact that the Court of Appeals held that such Order was not before the Court, the warrant for the arrest of John R. Marik is still outstanding and he is subject to arrest.

2. Petitioner is still plagued with the problem noted on pages 41 and 42 of the

Petition for Writ of Habeas Corpus, namely in being among that group of persons known as "middle class." He doesn't qualify to have various orders and judgments stayed as one proceeding in forma pauperis, nor does he have the financial resources to provide security for a stay of and order or judgment, not even to proceed with a Writ of Certiorari to this Court, which he desires to make. The grossness of the injustice is multiplied in this case for case law clearly shows that the Court of Appeals should have held that the Order in question was properly before the Court of Appeals. A party may appeal a contempt issue as a part of an appeal from a final judgment. *Thomassen v. U.S.*, 835 F.2d 727 (C.A. 9th., 1987); *Union of Prof. Airmen v. Alaska Aeronautical*, 625 F.2d 881 (C.A. 9th., 1980). A civil contempt order is an interlocutory order, a part of the underlying civil action. *Ibid.*, p. 883.

An order to show cause is preliminary to contempt order, and therefore it is also interlocutory in character, and appealable as part of an appeal from judgment. A preliminary provisions¹ order is interlocutory. *Grant v. Phoenix Mutual L. Ins. Co.*, 106 U.S. 429, 27 L.Ed 237, 12 S.Ct. 414 (1882). Accordingly, there was a proper appeal from the Order in question.

3. The grossness of the injustice accorded Petitioner is even further multiplied by the holding of the Court of Appeals that the term "Seventh-day Adventist" could not be determined to be generic as a matter of law from the historical facts for which Petitioner in his appeal had requested the Court take judicial notice under Fed.R.Evid. 201. Such Historical facts, in summary, are as follows: (1) Registrant of trademark "Seventh-day Adventist" showed a first use in 1860, but one of the founders of the

General Conference of Seventh-day Adventists, parent organization of trademark registrant from whom it claims a derived first use, stated in her book Early Writings, E.G. White, at page xx of the prologue: "Into their midst came a Seventh Day Baptist, Rachel Oakes, who distributed tracts setting forth the binding claims of the fourth commandment. Some in 1844 saw and accepted this Bible truth. One of their number, William Farnsworth, in a Sunday morning service, stood to his feet and declared that he intended to keep God's Sabbath of the fourth commandment. A dozen others joined him, taking their stand firmly on all of God's commandments. They were the first Seventh-day Adventists." (emphasis added). (2) there are hundreds of Seventh-day Adventist Churches which are not part of nor associated with the parent organization of trademark registrant of "Seventh-day Adventist," or with trademark

registrant, including the Seventh-day Adventist Church, Reform Movement, which itself is comprised of several branches, which each in and of itself has numerous Seventh-day Adventist Churches. The admission of Ellen G. White, who is considered by the Seventh-day Adventist Church to be a prophetess, is an admission against interest to that of the trademark registrant. It should also be noted that the Seventh-day Adventist, Reform Movement had its origin in Germany in 1914 as a result of their members being disfellowshipped from the Seventh-day Adventist Church for refusing to bear arms against the United States and its allies and thus violate the commandment "Thou shalt not kill." Many other instances could be mentioned, but such should be sufficient to show that the name "Seventh-day Adventist" should be held to be generic based on historical facts requested to be judicially noticed, and

thus usable by any adhering to the basic principles of Seventh-day Adventism. This principle of genericness was recognized in the holding of the court in Christian Science Bd. of Directors v. Evans, 105 N.J. 297, 520 A.2d 1347 (1987), cited by the Court of Appeals in the Opinion attached hereto at page 12436. Fed.R.Evid. 201 has been invoked in this case.

THEREFORE, Petitioner John R. Marik respectfully requests that an order be issued whereby the Court takes judicial notice of the Opinion of the United States Ninth Circuit Court rendered below on October 5, 1989, in the case of General Conference Corporation of Seventh-day Adventists v. Seventh-day Adventist Congregational Church and John R. Marik, Case No. 88-2506. Also, it is requested that the Court stay without requiring security all further proceedings in either

the Court of Appeals or the District Court
pertaining to such case until a Writ of
Certiorari may be presented to this Court.

DATED: Houston, Texas, October 22, 1989.

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FOR PUBLICATION
UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

GENERAL CONFERENCE
CORPORATION OF SEVENTH-DAY
ADVENTISTS,

Plaintiff-Appellee,

v. _____

SEVENTH-DAY ADVENTIST
CONGREGATIONAL CHURCH; JOHN R.
MARIK,

Defendants-Appellants.

No. 88-2506

D.C. No.
CV-87-0274 RES
OPINION

Appeal from the United States District Court
for the District of Hawaii
Russell E. Smith, Senior District Judge, Presiding

Argued and Submitted
May 11, 1989—San Francisco, California

Filed October 5, 1989

Before: Procter Hug, Jr., Mary M. Schroeder and
William C. Canby, Jr., Circuit Judges.

Opinion by Judge Canby

SUMMARY

Copyright, Patent and Trademark/Courts and Procedure

Reversing and remanding the district court's judgment, the
court held that a judgment on the pleadings is improper

12432 GEN. CONF. CORP. v. SEVENTH-DAY ADVENTISTS

where a defendant either raises questions of material fact or presents affirmative defenses.

Defendants Seventh-Day Adventist Congregational Church and John Marik appealed a judgment on the pleadings and the issuance of a permanent injunction against them in a trademark infringement action. Plaintiff General Conference Corporation of Seventh-Day Adventists brought a claim against defendants under the Lanham Act, 15 U.S.C. § 1051 et seq., for trademark and service mark infringement, unfair competition, and false designation of origin. Marik, pro se, and allegedly on behalf of the Congregational Church, filed a response and a denial of plaintiff's allegations. Because defendants filed no response to plaintiff's motion for judgment on the pleadings, the district court ordered that it be granted. Defendants' motion to set aside the judgment was denied, and defendants appealed.

[1] A judgment on the pleadings is a decision on the merits and it is reviewed de novo. [2] Defendants filed two pleadings which the district court construed as "answers." If these "answers" are construed liberally because Marik submitted them pro se, they set forth two points that either raise questions of material fact or present affirmative defenses. [3] Defendants claimed that the name Seventh Day Adventist is generic because it refers to a religion rather than the church organization. Defendants are not liable for trademark infringement if they prove that the mark is generic. Because this defense was raised in the answer, it bars a judgment on the pleadings. [4] Also in the answer, Marik made several factual assertions regarding the likelihood of confusion, and these factual allegations create a material issue of fact that should not have been determined in a judgment on the pleadings.

COUNSEL

Max A. Corbett and Peter N. Fowler, Annandale, Virginia,
for the defendants-appellants.

Lorraine H. Akiba, Honolulu, Hawaii, for the plaintiff-appellee.

OPINION

CANBY, Circuit Judge:

Defendants Seventh-Day Adventist Congregational Church and John Marik appeal a judgment on the pleadings and the issuance of a permanent injunction against them in a trademark infringement action. We reverse and remand for further proceedings.

BACKGROUND AND PROCEEDINGS BELOW

The General Conference Corporation of Seventh-Day Adventists sued the Seventh-Day Adventist Congregational Church, located in Kealahou, Hawaii, and its pastor, John R. Marik, under the Lanham Act, 15 U.S.C. § 1051 et seq., for trademark and service mark infringement, unfair competition, and false designation of origin. The General Conference also asserted claims under the common and statutory law of Hawaii relating to trademarks, service marks, trade names, unfair competition, deceptive trade practices, and false advertising. The complaint was filed on April 9, 1987. Marik, pro se, and allegedly on behalf of the Congregational Church, filed a response on May 18, 1987. The General Conference thought the response, which was in letter form, did not comply with the rules, and notified the defendants that it would give them an extension, until June 15, 1987, to file an amended answer. No amended answer was filed by that deadline.

On July 15, 1987, the General Conference filed a motion for judgment on the pleadings, or in the alternative, a motion to strike the answer of Marik and the Congregational Church.

A hearing on the motion was scheduled for September 8, 1987. On August 4, 1987, the defendants filed a "Denial of Plaintiff's Allegations." Pursuant to local rule, a scheduling conference was held August 10, 1987, before a magistrate. The magistrate advised Marik that the Congregational Church was an eleemosynary corporation and could not be represented pro se, and advised the Congregational Church to obtain legal counsel. The court continued the conference for that purpose.

The defendants filed no response to the motion for judgment on the pleadings. Because it received no opposition to the motion, the court ordered that judgment on the pleadings be granted, and denied the motion to strike. The judgment and a permanent injunction were entered December 8, 1987. The injunction prohibits the defendants from using a name that includes the term "Seventh Day Adventist" or "SDA," or promoting or representing to others that it is connected in any way with the General Conference. It also required the defendants to file a compliance report with the court within 30 days.

On December 28, 1987, the defendants, now represented by counsel, filed a motion for suspension of the injunction, a motion to set aside the judgment, and other related motions. On January 12, 1988, Marik and the Congregational Church filed a compliance report that stated that they refused to comply with the injunction because they believed the judgment was void for lack of subject matter jurisdiction, and because plaintiff's trademark was invalid. The General Conference responded with a motion to show cause why the defendants should not be held in contempt.

The district court denied defendants' motion to set aside the judgment, stating that the question whether "Seventh-Day Adventist" was a generic mark was one of law that had been decided in the judgment on the pleadings, and there was no reason to revisit the question upon a motion for new trial.

The defendants filed a notice of appeal on April 7, 1988. The district court then entered an order to show cause why defendants should not be held in contempt, and set a hearing for May 9, 1988. The district court held both Marik and the Congregational Church in contempt, set a fine of \$500 per day until compliance against both defendants, individually and collectively, and ordered that a warrant issue for Marik's arrest until full compliance with the injunction. The court also awarded plaintiff \$13,929.21 for attorneys' fees and costs incurred in pursuing the contempt order.

DISCUSSION

[1] A judgment on the pleadings is a decision on the merits, and we review it *de novo*. See *McGlinchy v. Shell Chemical Co.*, 845 F.2d 802, 810 (9th Cir. 1988). Judgment on the pleadings is proper when there are no issues of material fact, and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 12(c). All allegations of fact by the party opposing the motion are accepted as true, and are construed in the light most favorable to that party. *McGlinchy*, 845 F.2d at 810. As a result, a plaintiff is not entitled to judgment on the pleadings when the answer raises issues of fact that, if proved, would defeat recovery. Similarly, if the defendant raises an affirmative defense in his answer it will usually bar judgment on the pleadings. See 5 C. Wright & A. Miller, *Federal Practice and Procedure* § 1368 (1969).

[2] The defendants filed two pleadings—that the district court construed as “Answers.” If we construe these “answers” liberally because Marik had submitted them *pro se*,¹ see *United States v. Ten Thousand Dollars (\$10,000) in U.S. Currency*, 860 F.2d 1511, 1513 (9th Cir. 1988), they set forth two

¹Marik purported to answer for his church, an eleemosynary corporation. Not being an attorney, he could not answer for the church. The district court did not strike the answer, however. The church was represented by counsel by the time of its motion for new trial.

points that either raise questions of material fact, or present affirmative defenses. In the same permissive mode, the second "answer" filed after the motion for judgment on the pleadings, may be construed as an opposition to the motion. For these reasons, judgment on the pleadings was improper.

A. *Is "Seventh Day Adventist" a Generic Term?*

A trademark, even if it has become incontestable, is subject to the defense that the mark is generic. *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194-95 (1985). A trademark's function is to identify and distinguish the goods or services of one seller from another. 1. J. McCarthy, *Trademarks and Unfair Competition* § 12:1 (2d ed. 1984). A generic mark is one that tells the buyer what the product is, rather than from where, or whom, it came. *Id.* A generic mark cannot be subject to trademark protection because it does not indicate the product or service's origin, but is the term for the product or service itself. *Id.*

[3] The defendants claim that the name "Seventh Day Adventist" is generic: it refers to a religion, rather than the church organization. See *Christian Science Bd. of Directors v. Evans*, 105 N.J. 297, 520 A.2d 1347 (1987). Marik discussed the generic nature of the church name in his "Answers." Construing the "Answers" liberally, we find that Marik sufficiently raised the issue as an affirmative defense when he stated:

The phrase "Seventh-day Adventist" is not theirs alone, as they would like to claim, for it describes a system or set of Bible based christian beliefs, doctrines [sic], and standards. One, therefore, is not necessarily a Seventh-day Adventist because of what organization he may be affiliated with, but rather, he is a Seventh-day Adventist because of what he believes. Seventh-day Adventism is a particular faith, and those that conscientiously hold to that

faith are Seventh-day Adventists. For an example, there are many different "Baptist" churches, but they all have a very similar faith.

Even assuming everything the General Conference alleges is true, the defendants are not liable for trademark infringement if they prove that the mark is generic. Because this defense was raised in the answer, it bars a judgment on the pleadings.

B. *Likelihood of Confusion*

To establish trademark infringement, the plaintiff must prove that there is a likelihood of confusion from the defendant's use of a mark similar to plaintiff's. *See* 15 U.S.C. § 1114; *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1178 (9th Cir. 1988). Several factors are involved in determining likelihood of confusion, which is a question of fact. *See id.* at 1178-79; *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1355 (9th Cir. 1985) (*en banc*). These factors include: 1) the strength of the plaintiff's mark/name; 2) the proximity of the parties' goods; 3) similarity of the marks/names; 4) evidence of actual confusion; 5) marketing channels used; 6) likely degree of purchaser care; 7) defendant's intent in selecting the mark/name; and 8) likelihood of expansion of product lines. *Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1533-34 (9th Cir. 1989).

[4] In the "Answers," Marik makes several factual assertions regarding the likelihood of confusion. First, he notes that the Congregational Church has "never in any way sought to deceive or confuse any one in regards to our name." He also states that the word "congregational" in the name of his church is explanatory, and distinguishes the two different churches. He states that "people have been quick to recognize this," and that the church intentionally used the word "congregational" to clarify that they were not affiliated with the plaintiff. All of these factual allegations go to the issue of likelihood of confusion, and create a question of material fact

that should not have been determined in a judgment on the pleadings.

C. Other Matters

Defendants attempt to challenge the order of the district court holding them in contempt. That order was entered, however, after the notice of appeal was filed. The order appealed from was not stayed. The notice of appeal stated that the appeal was from the judgment and injunction entered on December 8, 1987, and from the order denying new trial entered on March 16, 1988. It does not bring before us the later contempt order, and we decline to rule upon it. Further relief, if any, must come from the district court.

Because the contempt order is not before us, we deny the motion to supplement the record on appeal with the record of the contempt proceedings. We also deny, as not in compliance with Fed. R. Evid. 201, defendants' motion to take judicial notice of certain "adjudicative facts."

Remaining points urged by the defendants are without merit.

CONCLUSION

The judgment on the pleadings in favor of plaintiff is **REVERSED**, and the cause is **REMANDED** to the district court for further proceedings.

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